

## REMARKS

This Application has been carefully reviewed in light of the Office Action mailed November 25, 2008. At the time of the Office Action, Claims 11-20 were pending in this Application. Claim 20 was previously withdrawn due to an election/restriction requirement. Claims 11-19 were rejected. Claim 11 has been amended to further define various features of Applicants' invention. Applicants respectfully request reconsideration and favorable action in this case.

### **Rejections under 35 U.S.C. §102**

Claim 11 was rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,403,311 issued to Abele et al. ("Abele"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the art cited as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

Claim 11 has been amended to recite that the electrode terminals are fixedly recessed within the chamber formed by the insulating shield. In contrast, Abele discloses a catheter with a retractable needle or probe, wherein the needle extends distally beyond the insulating shield to control the degree of exposed conductive surface (see column 6, row 40-43). Therefore, Abele does not disclose all of the elements of claim 11 as amended. For at least these reasons, Applicants respectfully submit that claim 11 as amended is in condition for allowance, and request withdrawal of the rejection.

### **Rejections under 35 U.S.C. §103**

Claims 12-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Abele in view of U.S. Patent No. 5,588,960 issued to Edwards et al. ("Edwards"). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

When determining whether a claim is obvious, the Examiner must make "a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, it is well settled that obviousness requires at least a suggestion of all the features in a claim. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (*citing In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, "*there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*" *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

Applicants hereby repeat and incorporate the comments made above with regard to claim 11. Specifically, claim 11 has been amended to recite that the electrode terminals are fixedly recessed within a chamber formed by the insulating shield. In contrast, Abele discloses a catheter with a retractable needle or probe, wherein the needle extends distally beyond the insulating shield to control the degree of exposed conductive surface (see column 6, row 40-43). Further, Edwards discloses a medical device with multiple tubular needles disposed through a curved path within a sheath and guide. The tubular needles extend distally relative to the guides and sheaths. As such, neither Abele nor Edwards, alone or in combination, at least suggest all of the elements of claim 11 as amended. For at least these reasons, Applicants respectfully submit that claim 11 as amended is in condition for allowance, and request withdrawal of the rejection.

Claims 12-19 depend either directly or indirectly from claim 11. Applicants repeat and hereby incorporate the remarks made above regarding amended claim 11. For at least these reasons, Applicants respectfully submit that claims 12-19 are in condition for allowance, and request withdrawal of the rejection.

**Information Disclosure Statement**

Applicants enclose an Information Disclosure Statement and PTO Form 1449, with copies of the references for the Examiner's review and consideration.

### CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

The Commissioner is hereby authorized to charge \$180 and any additional fees necessary or credit any overpayments to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.358.5925.

Respectfully submitted  
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Enclosure: 1) Information Disclosure Statement and PTO Form 1449, with copies of the references.